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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,512	11/16/2001	Howard Francis Willers	01-110	7394

7590   05/05/2005

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EXAMINER
DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 April 2005</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-30 have been examined.

Response to Amendment

2.   The Amendment filed on 4/6/05 is insufficient to overcome the Gerace, Angles, and

Nason reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace

(5,848,96) in view of Angles (5,933,811) in view of Nason (6,630,943) in view of Goldhaber

(5,794,210).

Claim 1, 11, 19, 20: Gerace discloses a method, medium, system of providing a system

for selective communication of promotional information among a plurality of sponsors and a

plurality of users over a computer network comprising the acts of:

a)   enrolling a plurality of sponsors, the act of enrolling each sponsor comprising the act of

assigning the sponsor with at least one group of customization parameters which are sufficient to

uniquely define the look and feel of a value portal skin (col 2, line 60-col, lines 10; col 6, lines

22-40; col 20, lines 10-25; col 18, lines 26-30);

b)   providing a sponsor server information in computer useable form to at least one of the

plurality of sponsors (col 18, lines 26-35), wherein the sponsor server software executing on a

sponsor server comprises functionality for communicating messages with a client software on a

user's computer over the computer network according to a special communication protocol (col

7, lines 47-56; col 7, lines 60-65; col 9, lines 39-45);

c)   providing the client information to a plurality of users in machine useable form (col 13,

lines 35-40; col 6, lines 22-35), each of said plurality of users having a user's computer capable

of using the client software and having access to the computer network, wherein each user's

computer operates under an operating system having a graphical user interface (col 6, lines 12-

22; col 3, lines 39-54; Fig. 1), and wherein the client software when executing on a user's

computer comprises:

i)   functionality for installing a value portal on the user's computer, the look and feel of the

value portal capable of being defined by any of the unique group of customization parameters

defining a value portal skin which have been assigned to each of the plurality of categories (col

11, lines 24-56; col 6, lines 23-40),

ii)   functionality for providing access to a plurality of additional utilitarian application

programs through said value portal (col 1, lines 10-14; col 2, line 60-col 3, line 3; col 22, lines

10-25),

iii)   a system database capable of storing a plurality of groups of customization parameters,

said system database comprising at least one group of customization parameters therein

corresponding to at least one sponsor of said plurality of sponsors (col 19, lines 18-31; col 20,

lines 19-25; col 11, lines 24-56; col 6, lines 23-40),

iv)   functionality for choosing which group of customization parameters from the plurality of

groups of customization parameters in the system database will be used to define the look and

feel of the value portal (col 12, lines 49-56; col 20, lines 10-19; col 11, lines 24-56; col 6, lines

23-40),

v)   functionality for exchanging messages with at least one sponsor through communication

with a sponsor server operated by the sponsor server software, according to the special

communication protocol (col 7, lines 47-56; col 7, lines 60-65; col 9, lines 39-45),

vi)   functionality for displaying messages on the value portal (col 7, lines 47-56; col 7, lines

60-65; col 9, lines 39-45), and

vii)   functionality for registering a user (col 4, lines 55-65) with a sponsor server (col 14, lines

30-36; col 22, lines 15-20; col 11, lines 24-56; col 6, lines 23-40) and executing the sponsor

software (col 18, lines 1-10).

Gerace further discloses software on the client and software on the sponsor server (col 1,

lines 47-50; col 18, lines 26-30).

Gerace further discloses multiple sponsors (col 14, lines 30-36; col 22, lines 15-20; col

18, lines 25-30). Gerace further discloses multiple categories of content (col 6, lines 27-35),

multiple content providers (col 1, lines 14-30), and that a content provider can be a sponsor or a

provider of content or a provider of advertising (col 2, lines 62-66).

Therefore, Gerace implies that there are multiple content provider sponsors such that

different categories of content can be supplied by different sponsors.

Gerace does note explicitly disclose that there are multiple content provider sponsors

such that different categories of content can be supplied by different sponsors.

Gerace does not explicitly disclose that the software can be run locally or on the client.

Gerace does not explicitly disclose that the sponsor can run sponsor software on the

server.

However, Angles discloses that there are multiple content provider sponsors such that

different categories of content can be supplied by different sponsors (Fig. 2).

Angles further discloses that the software can be run locally or on the client (col 3, lines

24-29; Fig. 11, item 12) and that client run software can be faster (col 12, lines 2-11).

Angles further discloses that the sponsor can run sponsor software on the server (col 12,

lines 40-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Angles special software located on the client or on the sponsor

server to Gerace's user with software or sponsor with software. One would have been motivated

to do this in order to allow greater flexibility and performance in various hardware and software

configurations.

Gerace further discloses that numerous aspects of presentation and format of the user

interface can be controlled and optimized (col 6, lines 13-21; col 5, lines 19-26).

Gerace does note explicitly disclose that the user interface can utilize a task bar.

However, Nason discloses the utilization of a customized portal (col 17, lines 5-13; col

17, lines 35-38; col 17, line 65-col 18, line 29) and the utilization of a task bar (Fig. 15; col 4,

lines 45-50)

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Nason's task bar to Gerace's customizable interface. One would

have been motivated to do this in order to provide further customization with an interface format

that many users are familiar with and find convenient.

Additionally, Gerace further discloses the user selecting categories of content of interest

and the user indicating categories to display content for (col 6, lines 21-41; col 11, lines 24-35;

col 11, lines 45-56; col 7, lines 52-57).

Goldhaber discloses that the user can indicate that only marketing messages from certain

categories of sponsors or advertisers will be received by the user:

"(43)   The demographic profiles can be constructed through interest questionnaires that

the consumer completes when subscribing to the service, and also through electronic tracking of

his/her usage of the service (and other habits). Thus, the profiles can be dynamic, evolving with

the customer's transaction history. A customer can choose to exclude any transaction (e.g.,

viewing of certain material or purchasing of certain products) from his profile. Profiles can also

be interactive in that a customer may edit his profile at any time to add or delete interest

features, and to delete any transaction records. Thus, for example, the customer can delete

historical transaction entries evidencing her purchase of an "adult" film if desired.

Similarly, the customer can change her profile to express interest in seeing certain types of

automobile advertisements, and then, after she has selected and purchased a new car, delete

those profile entries (col 6, lines 45-61);

(93)   Referring once again to FIG. 11A, the consumer's software agent 110 may also, if

desired, initiate the above-described matching process whenever the consumer's interest profile

124 changes (FIG. 11A, block 190). In this example, system 100 will track the consumer's

activities and elaborate the consumer's profile 124 automatically. In addition, system 100 in

this example permits the consumer to view and edit a plain-language representation of her

profile 124 at any time, and add anything to it or delete anything from it. Thus, for example, if

the consumer begins looking for a new car, she may edit her profile 124 to add an interest about

certain <u>types or categories</u> of automobiles. Such a change in the consumer's profile 124 may

cause software agent to re-index the consumer's profile 124 (FIG. I A, block 192) and a new

scan for matching ads (FIG. 11A, block 194)" (col 17, line 64-col 18, line 12).

Note that in Goldhaber that when the user indicates types or categories of automobiles of

interest that the user is choosing which sponsors to receiving marketing messages from. For

example, the user can choose to receive only ads from automobile marketers, or ads from

minivan automobile marketers, or ads from Toyota automobile marketers. Hence, Goldhaber

discloses the user chooses the sponsors to receive marketing messages from. Goldhaber

discloses that the user can choose a wide variety of criteria for preventing the reception of or

indicating an interest in receiving sponsor content.

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Goldhaber's user choosing which sponsors to receive marketing

messages from to Gerace's user indicating categories of content of interest. One would have

been motivated to do this in order to provide the user with further customization as to the type of

content the user is interested in.

Claim 2, 21: Gerace, Angles, and Nason and Goldhaber disclose the method, system of

claim 1, 21. Gerace further discloses that the act of providing at least one authentication server

operating with an authentication server software accessible to the computer network, said

authentication server being capable of authenticating a communication between one of said

plurality of user's computers operating the client software and a sponsor server operating the

sponsor server software communicating according to the special communication protocol (col

18, lines 35-40; col 13, lines 60-65; col 17, lines 17-25).

Claim 3, 4, 12, 13, 24: Gerace, Angles, and Nason and Goldhaber disclose the system,

medium, system of claim 2, 11, 23. Gerace further discloses that the plurality of additional

utilitarian programs are accessible only when the client software program is operating (col 4,

lines 55-60), and the functionality of the plurality of utilitarian programs is invariant to selection

of which group of customization parameters defines the look and feel of a value portal or the

value portal skin (col 1, lines 10-14; col 2, line 60-col 3, line 3; col 22, lines 10-25).

Gerace further implies that regular use of the client software is encouraged (col 4, lines

25-30; col 4, lines 15-18).

Therefore, it would be obvious to Gerace to encourage the user to utilize the system.

Gerace would be motivated to do this in order to better profile a user because the more a user

utilizes the system the better the user can be profiled.

Claim 5, 14: Gerace, Angles, and Nason and Goldhaber disclose the method, medium of

claim 4, 13. Gerace further discloses that the client software further comprises functionality for

periodically accessing at least one sponsor server to obtain messages according to the special

communication protocol (col 7, lines 47-56; col 7, lines 60-65; col 9, lines 39-45).

Claim 6, 15, 25: Gerace, Angles, and Nason and Goldhaber disclose the method,

medium, system of claim 5, 14, 24. Gerace further discloses that the client software further

comprises functionality for optionally updating the client software program and system database

on a user's computer during a communication according to the special message protocol (col 13,

lines 36-46; col 13, lines 62-col 14, line 4).

Gerace further discloses that the communication session is with a sponsor server (col 13,

lines 60-65).

Claim 7, 8, 16, 17, 27, 28: Gerace, Angles, and Nason and Goldhaber disclose the

method, medium, system of claim 6, 15, 25.

Gerace further discloses that numerous aspects of presenation and format of the user

interface can be controlled and optimized (col 6, lines 13-21; col 5, lines 19-26).

Gerace does not explicitly disclose that the value portal is installed overlaying the task

bar on the graphical user interface, or that the value portal is installed adjacent to the task bar on

the graphical user interface.

However, Nason discloses the utilization of a widely customized portal in terms of format

presentation and the utilization of a task bar (Fig. 15; Fig. 3; Figs 16-21; col 4, lines 45-50; col

17, lines 5-13; col 17, lines 35-38; col 17, line 65-col 18, line 29))

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Nason's task bar to Gerace's customizable interface. One would

have been motivated to do this in order to provide further customization with an interface format

that many users are familiar with and find convenient.

Claim 9, 18, 29: Gerace, Angles, and Nason and Goldhaber disclose the method,

medium, system of claim 6, 15, 25. Gerace further discloses that the client software launches an

application program with the value portal included thereon (col 22, lines 5-25; col 36, lines 54-

59).

Claim 10, 26, 30: Gerace, Angles, and Nason and Goldhaber disclose the method, system of claim 6, 25. Gerace further discloses that the client software, the sponsor server software, and the special message protocol contain functionality to enable a first user to exchange a message with a second user through a common sponsor server which both the first user and the second user periodically exchange messages (col 10, lines 25-39).

Gerace further discloses utilizing the special communications protocol (col 1, lines 44-48).

Claim 22: Gerace, Angles, and Nason and Goldhaber disclose the system of claim 21 wherein the computer network is the Internet (col 3, lines 50-53).

Claim 23: Gerace, Angles, and Nason and Goldhaber disclose the system of claim 22. Gerace further discloses that the at least one sponsor server comprises a plurality of sponsor servers which are each operated by at least one sponsor (Fig. 1; col 1, lines 45-49; col 3, lines 48-49).

Response to Arguments

4.   Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

On page 11 of the Applicant's Amendment dated 4/6/05, Applicant states, "There is no teaching or suggestion in Gerace, Angles, or Nason, individually, or in combination, for client software which includes 'functionality for allowing a user to select which sponsors' value portal skin to display, whereby the user chooses which sponsors to receive marketing messages from' as recited in amended claims 1, 11, 20."

However, please see the section above for the rejection of the independent claims that begins, "Additionally, Gerace further discloses the user selecting...".

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Robinson (5,918,014) discloses the user selecting certain companies to receive advertising from (paragraph 36).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The

examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arthur Duran
Patent Examiner
4/28/05

JEFFREY D. CARLSON
PRIMARY EXAMINER